

REMARKS

Entry of the foregoing, continued examination, and further and favorable reconsideration of the subject application, in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.114, are respectfully requested.

Status

On July 1, 2004, Applicants cancelled pending Claims 2-23, 25, and 27 (Claims 1, 24, and 26 had previously been cancelled), and added new Claims 28-41. Applicants respectfully request that the Examiner acknowledge the pendency of Claim 41.

Following Applicants' July 1, 2004, Amendment, a final Official Action was mailed. The final Official Action, mailed October 1, 2004, withdrew the previous rejections under 35 U.S.C. § 103(a). *See Final Official Action mailed October 1, 2004, Page 2.* The final Official Action then rejected Claims 28-36, 40, and 41 under 35 U.S.C. § 102(e) as purportedly anticipated by U.S. Patent Application Publication Nos. 2002/0051749 (now U.S. Patent No. 6,803,052) to Faisant *et al.* ("Faisant I") and 2003/0175356 also to Faisant *et al.* ("Faisant II"). *Id.* at Pages 3-4. Finally, Claims 28-40 were provisionally rejected under 35 U.S.C. § 101 as allegedly claiming the same invention as that of claims 1-15 of copending U.S. Patent Application Serial No. 10/451,216, published as U.S. Patent Application Publication No. 2004/0180095 to Menei *et al.* ("Menei"). *Id.* at Pages 4-5.

Following the October 1, 2004, final Official Action, Applicants filed, on January 31, 2005, an Amendment Under 37 C.F.R. § 1.116 and a Declaration Under 37 C.F.R. § 1.132.

An Advisory Action was mailed February 22, 2005, indicating that the Request for Reconsideration did not place the application in condition for allowance.

Summary of Claim Amendments

By the foregoing amendments, Applicants have amended Claims 29 and 32-41 to correct minor, typographical, and/or linguistic errors. Specifically, Applicants have amended Claims 29 and 32-41 to read "[a] method according to"

Accordingly, no new matter has been added.

Rejection of Claims 28-36, 40, and 41 Under 35 U.S.C. § 102(e) Over Faisant I and/or Faisant II

Claims 28-36, 40, and 41 were rejected under 35 U.S.C. § 102(e) as purported anticipated by Faisant I and/or Faisant II. *See Final Official Action mailed October 1, 2004, Pages 3-4.* This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (Fed. Cir. 1987); *See M.P.E.P. § 2131.* Applicants respectfully assert that neither Faisant I nor Faisant II contain each and every element of Claims 28-36, 40, and 41, thereby precluding anticipation. In the alternative, Applicants respectfully assert that neither Faisant I nor Faisant II is the work of "another" pursuant to 35 U.S.C. § 102(e).

A. Lack of Anticipation

Regarding the purported anticipation, method Claims 28-36, 40, and 41 require that microcapsules be stereotactically-injected *directly into* a tumor, peritumoral area, or at the same time into both a tumor and the peritumoral area. Contrarily, Faisant I and Faisant II rely upon *implanting* microcapsules into the operating locus *after excision of the tumor*. See, e.g., *Claim 1 from each of Faisant I and Faisant II*.

At least because Faisant I and Faisant II fail to disclose each and every element of Claims 28-36, 40, and 41, *i.e.*, the element of microcapsules being stereotactically-injected directly into a tumor, peritumoral area, or at the same time into both a tumor and the peritumoral area, neither Faisant I nor Faisant II anticipate Claims 28-36, 40, and 41. Applicants respectfully request withdrawal of the 35 U.S.C. § 102(e) rejection of Claims 28-36, 40, and 41 over Faisant I and/or Faisant II.

B. Not the Work of “Another”

Even if the Examiner does not agree that Claims 28-36, 40, and 41 are not anticipated by Faisant I and/or Faisant II, the pending 35 U.S.C. § 102(e) rejection is improper because the relied-upon material from Faisant I and/or Faisant II is not the work of “another,” as it pertains to 35 U.S.C. § 102(e).

“The fact that an application has named a different inventive entity than a patent does not necessarily make that patent prior art.” *Applied Materials Inc. v. Gemini Research Corp.*, 835 F.2d 279 (Fed. Cir. 1988); see *M.P.E.P.* § 2136.05. Faisant I lists as inventors : (1) Nathalie FAISANT, (2) Jean-Pierre BENOIT, and (3) Philippe MENEI. Faisant II lists the same inventors Faisant I, *i.e.*, (1) Nathalie

FAISANT, (2) Jean-Pierre BENOIT, and (3) Philippe MENEI. The instant application lists (2) Jean-Pierre BENIOT and (3) Philippe MENEI as inventors.

As indicated in the Declaration filed January 31, 2005, Nathalie FAISANT, Jean-Pierre BENOIT, and Philippe MENEI "are variously co-inventors of subject matter claimed in U.S. Patent Application Publication No[s]. 2002/0051749A1 and 2003/0175356A1 [*i.e.*, Faisant I and Faisant II, respectively]." *See Declaration, Paragraph 1.* Also as indication in the Declaration filed January 31, 2005, Jean-Pierre BENOIT, and Philippe MENEI "are co-inventors and co-applicants in the referenced [*i.e.*, *this*] application." *See Declaration, Paragraph 2.* Further as indicated in the Declaration filed January 31, 2005, "[i]nsofar as any of the claimed subject matter [in this application] was also disclosed in either of [Faisant I or Faisant II], the instant co-inventors, Benoit and Menei, conceived or invented such common subject matter." *See Declaration, Paragraph 3.* Put differently, all three (3) inventors of Faisant I and Faisant II agree, as evidenced by their signatures on the Declaration filed January 31, 2005, that the relied-upon material from Faisant I and Faisant II was conceived or invented by the inventors of this application, Benoit and Menei. As a result, neither Faisant I nor Faisant II is the work of "another," as it pertains to 35 U.S.C. § 102(e).

In light of the foregoing, Applicants respectfully request that the rejection of Claims 28-36, 40, and 41 as anticipated by Faisant I and/or Faisant II be withdrawn.

Rejection of Claims 28-40 Under 35 U.S.C. § 101 Over U.S. Patent Application Serial No. 10/451,216 to Menei et al.

Claims 28-40 were rejected under 35 U.S.C. § 101 as purportedly claiming the "same invention" as U.S. Patent Application Serial No. 10/451,216 to Menei *et al.* ("Menei"). See *Final Official Action* mailed October 1, 2004, Pages 4-5. This rejection is respectfully traversed.

As set forth in M.P.E.P. § 804, when an Examiner issues a provisional double-patenting rejection over another application and the double-patenting rejection is the only rejection remaining in one of the applications [as Applicants believe it would be, following withdrawal of the 35 U.S.C. § 102(e) rejection], "the examiner should then withdraw that rejection and permit the application to issue as a patent." Because Menei, according to the PTO's status information as of the date of this filing, is still "awaiting examination," and no patent has yet issued, Applicants respectfully request that the provisional double-patenting rejection be withdrawn.

Request for Return of Examiner-Initialed PTO-1449 Forms

On January 24, 2002, Applicants filed a first IDS and corresponding PTO-1449 Form. On February 13, 2002, Applicants filed a second IDS and corresponding PTO-1449 Form. On March 25, 2002, Applicants filed a third IDS and corresponding PTO-1449 Form. Applicants hereby attach a fourth IDS and corresponding PTO-1449 Form.

Applicants respectfully request, with the Notice of Allowance or next Official Action, that an Examiner-initialed copy of these four (4) PTO-1449 Forms be returned to Applicants.

Request for Personal Interview Prior to Next Official Action

Applicants respectfully request a personal interview with the Examiner *prior to issuance* of the next Official Action. Applicants believe the foregoing information lends itself to in-person communication that will readily dispose of the outstanding issues. Applicants invite the Examiner to telephone the undersigned attorney at the number listed below to schedule the interview.

CONCLUSION


From the foregoing, further and favorable consideration in the form of a Notice of Allowance is respectfully requested and earnestly solicited.

In the event that there are any questions relating to this Amendment and Reply, or the application in general, it would be greatly appreciated if the Examiner would telephone the undersigned attorney concerning such questions so that prosecution for this application may be expedited.

Respectfully submitted,
BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: April 1, 2005

By: _____


Erin M. Dunston
Registration No. 51,147

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620